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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,082	01/30/2001	Yasuhisa Mori	503.39420X00	8192

20457 7590 06/04/2004

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EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 06/04/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,082

Applicant(s)

MORI ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been examined.
2. Claims 1-26 are now pending.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which have been placed of record in the file under Paper #2.

Claim Objections

4. Claims 23 and 24 are objected to because of the following informalities:
 - Claim 23 contains a grammatical error on page 33, line 7 when stating "...in a destination database an information processor."

Claim 24 is also objected to due to its dependence on claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 6 recites the limitation "said mail dividing information" on page 27, lines 25-26.

There is insufficient antecedent basis for this limitation in the claim. For the purpose of applying prior art, it will be assumed that the claim reads "...sections and based on mail dividing information attached..."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 20, 21, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shoujima (U.S. Patent Number 5,754,778).

10. Shoujima has disclosed:

- <Claim 20>

A recording medium storing an electronic mail processing program for realizing an electronic mail function by loading the electronic mail processing program into an information processor, wherein said electronic mail processing program includes a program executing: processing for comparing an upper limit value of sent mail size with a size of mail to be sent (column 3, lines 14-18); and processing for sending the mail by automatically dividing the mail data to be sent into a plurality of sub-mail sections when the size of the mail to be sent exceeds the upper limit value of sent mail size (column 3, lines 18-30).

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- <Claim 21>

A recording medium storing an electronic mail processing program according to claim 20, which further includes a program for executing mail dividing information adding processing for adding information into sent mail data, said information being necessary for reconstituting divided items of divisional sub-mail data to a single original item of mail data (column 4, lines 1-6).

- <Claim 25>

A recording medium storing an electronic mail processing program according to claim 20, which further includes a program executing processing for automatically changing a subject name of each of items of sub-mail data to each subject name corresponding to number of divided sections and dividing order of each of the items of sub-mail data (column 4, lines 1-14).

Since all the limitations of the invention set forth in claims 20, 21, and 25 were disclosed by Shoujima, claims 20, 21, and 25 are rejected.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-7, 10-15, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoujima in view of Monroe (U.S. Patent Number 6,130,917).

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13. Shoujima disclosed an electronic mail system where the mail is divided into portions which are sequentially sent to a receiving terminal to be displayed. In an analogous art, Monroe disclosed an instant protocol selection scheme for electronic data transmission. Just as Shoujima's invention, Monroe's system is concerned with transforming data for transmission so that it can be properly received by a receiving terminal. See column 2, lines 27-43.

14. Concerning claims 1, 14, 22, and 26, Shoujima's system actively divides the mail to be transferred and processes it in different ways. The system divides the mail into smaller portions and attaches specific dividing information to each of the portions as discussed above. However Shoujima did not explicitly state that his system could utilize a database for storing information about the destination terminal or that his system could automatically provide a means for recombining the email to the destination if the destination did not already have such means. Monroe's system does accomplish these tasks, though. Monroe introduces a database that stores information about the destination of the data transfer in order to aid in the transfer process. See column 5, lines 14-24. He also states the use of a protocol check scheme. This scheme automatically transfers protocol information to the receiving terminal when it is needed in order to allow the terminal to properly process the data being transferred. See column 6, lines 25-32. This rationale has also been applied to claims dependent on 1 and 14 that contain similar limitations as cited below in more detail.

15. Although Monroe's system is not necessarily focused on email as Shoujima's is, both systems utilize processes that ensure that data being transferred can properly be processed at its destination. Since the inventions of Shoujima and Monroe encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the

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applicant's invention to modify the system provided by Shoujima by adding such functions as a destination database and a provision for aiding the destination in processing as provided by Monroe. This combination would make sense because it would enhance Shoujima's data transfer environment, making it more reliable and efficient.

16. Concerning the claims which discuss display units (here, namely claims 11 and 15), the combination of Shoujima and Monroe does not necessarily describe a display unit at the server computer, but a display unit at the receiving computer is discussed. It is evident that the information being transferred could have originated at a computer similar to the receiving computer and thus this device would also have a display unit. See Shoujima, column 1, lines 10-15. It is obvious to one of ordinary skill in the art that a process for transferring data can be displayed to the user at both the source and the destination.

17. Thereby, the combination of Shoujima and Monroe discloses:

- <Claim 1>

An information processor having an electronic mail function, which comprises: a mail size upper limit value storing means for storing at least one upper limit value of a sending destination mail size (Monroe, column 6, lines 3-13); a mail size comparing means for comparing said upper limit value stored in said mail size upper limit value storing means with a size of a mail main part of sent mail (Shoujima, column 3, lines 24-18); a sent mail dividing means for dividing said sent mail into a plurality of sub-mail sections when the size of said sent mail exceeds said mail size upper limit value (Shoujima, column 3, lines 18-40); and a mail sending means for sequentially sending sets of information individually including said sub-mail sections (Shoujima, column 3, lines 58-65).

- <Claim 2>

An information processor having an electronic mail function according to claim 1, which further comprises a destination-based information registration database, data being registered in said destination-based information registration database, said data being destination-based information including whether or not a mail address, a mail upper limit value and a divided mail reconstituting program for reconstituting said plurality of sub-mail sections to the original mail exist in each destination (Monroe, column 5, lines 31-40 and column 6, lines 3-13).

- <Claim 3>

An information processor having an electronic mail function according to claim 2, which further comprises means for setting data to said destination-based information registration database, said data being information on judging whether or not there is necessity of attaching said reconstituting program (Monroe, column 6, lines 3-13).

- <Claim 4>

An information processor having an electronic mail function according to claim 1, which further comprises a mail dividing information adding means for adding mail dividing information necessary for reconstituting said plurality of divided sub-mail sections to the original mail form to each of said sets of information (Shoujima, column 4, lines 1-6).

- <Claim 5>

An information processor having an electronic mail function according to claim 4, wherein said mail dividing information attached to each of the sub-mail sections includes an identification code for identifying the original mail, sub-numbers for expressing order

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of said sub-mail sections, a dividing number of the mail, and a capacity of each of said sub-mail sections (Shoujima, column 4, lines 1-35).

- <Claim 6>

An information processor having an electronic mail function according to claim 2, wherein said reconstituting program is a program for reconstituting said original mail based on all said received sub-mail sections and based on mail dividing information attached to each of said sub-mail sections (Shoujima, column 3, lines 31-47).

- <Claim 7>

An information processor having an electronic mail function according to claim 2, which further comprises means for automatically attaching said dividing mail reconstituting program to sent mail when it is judged that a destination does not have said divided mail reconstituting program (Monroe, column 6, lines 25-37).

- <Claim 10>

An information processor having an electronic mail function according to claim 1, which further comprises means for setting a subject name for each of the sub-mail sections, said subject name being a name of an original mail added with data corresponding to number of divided sections and dividing order of said sub-mail sections (Shoujima, column 4, lines 1-14).

- <Claim 11>

An information processor having an electronic mail function according to claim 1, wherein it is displayed on a display unit of said information processor that sent mail is divisionally being sent (Shoujima, column 1, lines 10-15 and column 4, lines 46-54).

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- <Claim 12>

An information processor having an electronic mail function according to claim 1, wherein said dividing number is set so as to be minimized (Shoujima, column 4, lines 36-54).

- <Claim 13>

An information processor having an electronic mail function according to claim 1, wherein said dividing number is set so as to equalize capacities of the sub-mail sections (column 3, lines 53-57).

- <Claim 14>

An information processor having an electronic mail function, which comprises: a mail dividing judging means for judging whether or not mail dividing information is added in received mail data (Monroe, column 6, lines 25-37); a divided-mail receiving judging means for judging referring to the mail dividing information whether or not all of sending sub-mail sections can be received (Monroe, column 6, lines 25-37); and a mail reconstituting means for reconstituting the sections of sending sub-mail data to a form of a single original item of sending mail data (Shoujima, column 3, lines 31-47).

- <Claim 15>

An information processor having an electronic mail function according to claim 14, wherein it is displayed on a display unit of said information processor that received mail is divisionally being sent (Shoujima, column 4, lines 46-54).

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- <Claim 22>

A recording medium storing an electronic mail processing program according to claim 21, which further includes a program executing: processing for attaching a reconstituting program for reconstituting divided items of divisional sub-mail data to a single original item of mail data (Monroe, column 6, lines 25-37); and processing for setting to a destination database whether or not attaching of said reconstituting program is necessary (Monroe, column 6, lines 3-13).

- <Claim 26>

A recording medium storing an electronic mail processing program for realizing an electronic mail function by loading the electronic mail processing program into an information processor, wherein said electronic mail processing program includes a program executing: mail dividing information judging processing for judging whether or not mail dividing information is attached to received mail data (Monroe, column 6, lines 25-37); divided mail receiving judging processing for judging based on the mail dividing information whether or not all necessary items of divisional sent sub-mail data have been received (Monroe, column 6, lines 25-37); and mail reconstituting processing for reconstituting the received plurality of items of divisional sent sub-mail data to a single original item of sending mail data (Shoujima, column 3, lines 31-47).

Since the combination of Shoujima and Monroe discloses all of the above limitations, claims 1-7, 10-15, 22, and 26 are rejected.

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18. Claims 8, 9, 16-19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shoujima and Monroe in view of Kennedy (U.S. Patent Number 6,134,582).

19. The combination of Shoujima and Monroe discloses an electronic mail system for divisionally sending mail to a destination utilizing a database of destination information and a means for aiding the destination in the processing of the transferred data, as discussed above. In an analogous art, Kennedy disclosed a system for managing electronic mail messages using a client-based database. Just as the combination of Shoujima and Monroe, Kennedy's system uses a database of client and message-related information to support the communication operations of the system. See column 2, lines 40-48.

20. Concerning claims 8, 16, 18, and 23, the combination of Shoujima and Monroe did not explicitly disclose that the system could utilize an input value for the mail size upper limit or that the system could send an email as normal if it is small enough. However, Kennedy did disclose these features. Furthermore, since the combination of Shoujima and Monroe and the invention of Kennedy both maintain the goal of managing the transfer of electronic mail through a client-based database, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Shoujima and Monroe by adding the ability to input the mail size upper limit and the ability to normally send mail when it is small enough as provided by Kennedy. This would make sense because it would allow the previous combination greater user control and flexibility in managing electronic mail messages. This rationale has also been applied to claims dependent on 8, 16, 18, and 23 that contain similar limitations as cited below in more detail.

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21. Thereby, the combination of Shoujima, Monroe, and Kennedy discloses:

- <Claim 8>

An information processor having an electronic mail function according to claim 1, wherein said mail size upper limit value storing means comprises a mail size upper limit value storing part; and a mail size upper limit value input means for inputting a mail size upper limit value for each destination, said mail size upper limit value being stored in said mail size upper limit value storing part (Kennedy, column 17, lines 41-43).

- <Claim 9>

An information processor having an electronic mail function according to claim 8, wherein said mail size upper limit value storing means further comprises a mail size upper limit value switching means for switching a mail size upper limit value used by said mail size comparing means corresponding to a destination (Kennedy, column 11, lines 2-4 and column 17, lines 41-43).

- <Claim 16>

A method of sending a receiving electronic mail, the method comprising the steps of: accepting a request of sending mail (Shoujima, column 3, lines 14-30); acquiring a mail size upper limit value of a destination based on an address of said destination (Shoujima, column 3, lines 14-40); comparing a size of the mail to be sent with said mail size upper limit value of the destination (Shoujima, column 3, lines 14-40); dividing the mail to be sent into sub-mail sections according to an appropriate dividing method and sending the sub-mail sections by attaching dividing information to each of the sub-mail sections, when the size of the mail to be sent is larger than said mail size upper limit value of the

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destination (Shoujima, column 3, lines 14-40 and column 4, lines 1-6); attaching a reconstituting program of divided mail to the sent mail when the reconstituting program is not provided to the destination (Monroe column 6, lines 3-13); and directly sending the mail to be sent when the size of the mail to be sent is smaller than said mail size upper limit value of the destination (Kennedy, column 17, lines 41-50).

- <Claim 17>

A method of sending and receiving electronic mail according to claim 16, wherein when the mail to be sent is divisionally sent, it is displayed on a display unit that the mail is divisionally sent (Shoujima, column 1, lines 10-15 and column 4, lines 46-54).

- <Claim 18>

A method of sending and receiving electronic mail, the method of comprising the steps of: judging whether or not received mail is divisionally being sent (Monroe, column 6, lines 25-37); after receiving all sub-mail sections, reconstituting the received sub-mail sections to a mail before divided using a reconstituting program and dividing information attached to each of the mail sections when the received mail is divisionally sent (Shoujima, column 3, lines 31-47); and executing normal receiving processing when the received mail is not divisionally sent (Kennedy, column 17, lines 41-50).

- <Claim 19>

A method of sending and receiving electronic mail according to claim 18, wherein when the received mail is divisionally sent, it is displayed on a display unit that the mail is divisionally sent (Shoujima, column 4, lines 46-54).

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- <Claim 23>

A recording medium storing an electronic mail processing program according to claim 20, which further includes a program executing: mail size upper limit value setting processing for setting an upper limit value of sent mail size (Kennedy, column 17, lines 41-43); mail size upper limit value storing processing for storing the upper limit value of sent mail size set in the mail size upper limit value setting processing in a destination database an information processor (Monroe, column 5, lines 31-40 and column 6, lines 3-13 and Kennedy, column 17, lines 41-43).

- <Claim 24>

A recording medium storing an electronic mail processing program according to claim 23, which further includes a program executing processing for switching the upper limit value of mail size referring to said destination database corresponding to a destination (Kennedy, column 11, lines 2-4 and column 17, lines 41-43).

Since the combination of Shoujima, Monroe, and Kennedy discloses all of the above limitations, claims 8, 9, 16-19, 23, and 24 are rejected.

Conclusion

22. The prior art made of record and not relied upon is consider pertinent to the applicant's disclosure.

- Eguchi (U.S. Patent Number 6,219,150) disclosed a communications terminal device having an electronic mail function and capable of reproducing a single original image even if it receives a plurality of electronic mails.

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- Fukazawa (U.S. Patent Number 6,633,399) disclosed a system that combines a predetermined amount of divided mail data in order to restore the undivided original data file for printing.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 703-308-6165.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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